

REMARKS

Unity of Invention

Claims 1-24 are pending and are subject to a Unity of Invention restriction under 35 U.S.C. §§ 121 and 372 for reciting inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. (*See*, Office Communication, at page 2). Applicants respectfully traverse.

The Examiner has required election in the present application between:

Group I, claims 1-21 and 24, drawn to a method of transforming monocotyledonous plant embryos with *Agrobacterium*, wherein copper-containing medium is employed; and

Group II, claims 22-23, drawn to a method of regenerating untransformed plants on a copper-containing medium.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, Claims 1-21 and 24.

Applicants bring to the Examiner's attention that claim 23 was placed into Group II. Applicants respectfully traverse. Claim 23 reads as follows:

23. (Previously Presented) The process of claim 17, wherein the concentration of the metal salt is 1-10 μM .

Claim 23 further limits the concentration of the metal salt from 1-50 μM to 1-10 μM in the process of claim 17 (which depends from 15 or 16). Applicants respectfully submit that claim 23 should be within Group I.

According to MPEP § 803, if the search and examination of an entire application can be made without a serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.

Applicants respectfully disagree with the Examiner's interpretation of the unity of invention. According to MPEP § 1850, Determination of "Unity of Invention," with respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. Independent claims 1, 15 and 22 involve an interrelationship of a medium enriched in a metal salt containing copper ion between methods. Also according to MPEP § 1850, although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented.

Since Group I (claims 1-21 and 24, directed to a method of transforming monocotyledonous plant embryos) and Group II (claims 22-23, where claim 23 depends from claim 17, which depends from claims 15 or 16 within Group I, and claim 22 is drawn to a method of promoting the growth of regenerated plants) are so closely related in subject matter, by searching one group the Examiner is necessarily searching the other group.

This is exemplified by claim 23, which depends from claim 17 within Group I. The subject matter of claim 23 is the same subject matter of the claims of Group I. The Examiner

would indeed be searching the same subject matter for claim 23 as in Group I; hence there would be no undue burden.

Also according to MPEP § 1850, although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented.

Therefore, in light of the above arguments, there is unity of invention within the claims since they involve an interrelationship of a medium enriched in a metal salt containing copper ion between methods. Because of this interrelationship within the claims, it would not be an undue burden to search all of claims 1-24. As such, Applicants respectfully request that the Examiner rejoins Groups I-II.

At a minimum, Applicants respectfully request that the Examiner rejoin claim 23 into Group I based on the discussion above.

Reconsideration and withdrawal of the Unity of Invention Restriction Requirement of claims 1-24 are respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Paul D. Pyla, Registration No 59,228, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated:

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Respectfully submitted,

By 

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